



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/010,476	12/07/2001	Norbert O. Reich	G&C 30794.30-US-D1	8266

7590 12/08/2004
Attn: Karen S. Canady
Gates & Cooper LLP
Howard Hughes Center
6701 Center Drive West, Suite 1050
Los Angeles, CA 90045

EXAMINER

MCINTOSH III, TRAVISS C

ART UNIT	PAPER NUMBER
----------	--------------

1623

DATE MAILED: 12/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

10/010,476

Applicant(s)

REICH ET AL.

Examiner

Traviss C McIntosh

Art Unit

1623

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 09 November 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 21-27 and 32-35.

Claim(s) withdrawn from consideration: 28-30.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

DETAILED ACTION

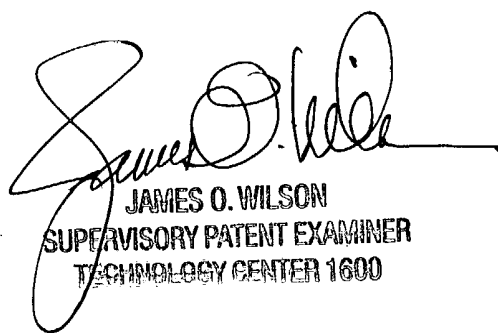
The amendment filed November 9, 2004 will not be entered because the newly added claims include sequence ID's which were not previously present in the pending claims, and would require further search and consideration. Moreover, the proposed amendment intends to add additional claims without canceling the corresponding number of finally rejected claims.

Response to Arguments

Applicant's arguments filed November 9, 2004 have been fully considered but they are not persuasive. Applicants argue that Sufrin fails to teach the steps of (a) inhibition, (c) formation of the enzyme/inhibitor complex in the presence of DNA, or (e) binding to the allosteric site of the DCMTase. As set forth in the previous office action, the fact that steps (b), contacting DCMTase with a synthetic inhibitor molecule, and (d), that the inhibitor molecule comprises a C-5 methylcytosine molecule, are recognized by applicants as being practiced, the method of Sufrin et al. must have inherently performed the steps as instantly claimed as the same active agent is known to inhibit the same enzyme. Moreover, applicants argue that Sufrin et al. does not teach inhibition via binding to al allosteric site and that the prior art does not teach contacting DCMTase with an inhibitor in the presence of DNA. However, the examiner notes that the enzyme DCMTase is known to methylate DNA, thus the inhibition of the enzymes activity as taught by Sufrin et al. must have been performed in the presence of DNA, as DNA is what DCMTase acts upon, and thus inhibiting the activity of the enzyme as taught by Sufrin et al. would necessarily require DNA to be present to determine if the enzyme did or did not subsequently methylate the DNA in the presence of their 5-methylcytosine containing moieties.

Art Unit: 1623

Additionally, applicants state that the examiner is viewing the DNA of Sufrin's substrate as both the DNA and the inhibitor of applicant's claims. However, applicant's claims are silent to the fact that these must be different molecules, and Sufrin is seen to read on the claims, as Sufrin shows that c-5 methylcytosine inhibits the activity of DCMTase. Applicants are not entitled to a patent to a method of inhibiting the activity of the enzyme by contacting it with compound which is already known in the art to inhibit the same enzyme.



JAMES O. WILSON
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600